

## REMARKS/ARGUMENTS

Claims 2-9 are currently pending in this application, with claim 9 being independent. By the amendment above, claims 2-9 have each been amended. It is believed that the amendments to claims 2-8 are cosmetic only. No new matter has been added by any of the amendments.

In the Final Rejection in the parent application, the Examiner objected to claims 4 and 9 for certain alleged informalities. By the amendments above, these informalities have been corrected. Specifically, claim 4 has been amended to refer to the haptic “element” rather than the haptic “portion” to conform the language of claim 4 to the language used in claim 9 to refer to the same element. In addition, claim 9 was amended as requested by the Examiner to state that the “peripheral surface” is “cylindrical” as recited previously therein. Withdrawal of these objections is therefore respectfully requested.

The Examiner also called for the amendment of claim 9, line 26, to delete the word “and” and to insert a comma (“,”) therein. The comma was inserted, but it is believed that the “and” should remain, as the comma makes clear that the step is formed by the offset between the posterior optical surface of the circular optical portion and the posterior face of each haptic element, and also that the side face of the radial extension forms a square-edged portion with the posterior face of the radial extension. Therefore, it is believed that the amendment clarifies any informality, and withdrawal of this objection, too, is respectfully solicited.

The Examiner then rejected claims 2-9 under 35 U.S.C. § 112 (2d para.) as allegedly being indefinite for failing to point out and distinctly claim the invention. Specifically, the Examiner referred to the language in claim 9, the sole independent claim, that the “cylindrical peripheral surface [has] a diameter D1”. The Examiner stated that “[t]he ‘cylindrical peripheral surface having a diameter D1’ is not well characterized since, from the claim language, an arbitrary line characterizes the diameter of said surface”. The applicant respectfully disagrees with this

characterization of the cited limitation of claim 9. The language simply identifies that the cylindrical peripheral surface has a diameter, as all cylinders do, and that that diameter is called "D1". "D1" is not an arbitrary line, rather it is the name given to the diameter of the cylinder which defines the cylindrical peripheral surface, to distinguish it from other defined diameters in the claimed implant. However, in the interests of eliminating any potential for indefiniteness, the reference to "D1" has been eliminated from claim 9, and references in claims 6-8 to "the diameter D1" have been changed to "said diameter of said cylindrical peripheral surface". It is believed that this amendment is cosmetic only. Withdrawal of this rejection is therefore respectfully solicited.

Next, the Examiner rejected claim 2 as lacking an antecedent basis for the terms "the length  $h$  and  $h'$  of the side faces" and suggested a specific amendment to claim 2 to resolve the antecedent issue identified by the Examiner. By the amendment above, the applicants have adopted the Examiner's suggestion, and so withdrawal of this rejection is also respectfully solicited. It is believed that this amendment, as well, is cosmetic only.

Finally, the Examiner rejected claims 2-9 under 35 U.S.C. 102(b) as anticipated by United States Patent No. 5,713,958 (Weiser). The applicants have carefully considered the Examiner's rejections, and the reasons offered in support thereof, and respectfully submit that their invention as claimed is neither taught nor suggested by Weiser.

The claimed invention is directed to a unitary intraocular implant for a capsular bag. The claimed implant includes: a circular optical portion having a cylindrical peripheral surface which is uncovered by any other element of the implant except at its periphery; at least one haptic element; and at least one radial extension disposed between the circular optical portion and the haptic element.

Weiser, on the other hand, discloses an intraocular implant composed of two *separate* portions relatively movable with respect to one another: lens 22, and ring 12 having a haptic portion

defined by haptic loops 16, 18 (col. 3, lines 16-28). Weiser specifically calls for lens 22 to be rotatable about its axis relative to the haptic portion (col. 3, lines 51-52). This differs from the claimed unitary implant of the invention.

Wewiser also lacks a cylindrical peripheral surface such as claimed. The Examiner has taken the position that ring 94 of Weiser (*see*, Fig. 5) corresponds to the claimed cylindrical peripheral surface of the inventive implant. As made clear by the amendment above, however, the cylindrical peripheral surface of the claimed invention is uncovered by any other element of the implant, while ring 94 in Weiser is covered by a portion of lens 90 at the periphery thereof.

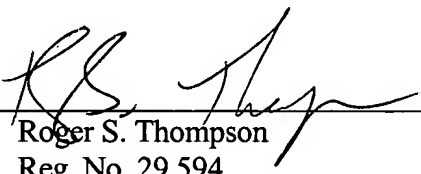
Furthermore, the implant taught by Weiser does not meet another limitation of claim 9. Claim 9 specifically recites that the length (h') of the side face of radial extension is substantially equal to the length (h) of the peripheral surface. The Examiner has defined the cylindrical peripheral surface of Weiser as ring 94, and the radial extension as "the L-shaped ends formed by ring 94 and lens 90" shown in Fig. 5 of Weiser. The length of the side face of the element so defined is the length h' as shown by the Examiner in the Figure reproduced on page 5 of the Final rejection. The Examiner then defined the length of the cylindrical peripheral surface h as the same distance. However, since the Examiner has defined ring 94 of Weiser as corresponding to the claimed cylindrical surface, it is *the length of ring 94* which must be compared to the defined length of the cylindrical surface (h). The length of ring 94 is far greater than the length of the "radial extension" (as defined by the Examiner in the reproduced Figure) of the structure shown in Weiser. Attached is a markup of the figure reproduced by the Examiner in the Final Rejection showing the actual length of ring 94 (with the reference designation L), illustrating the disparity of the length thereof (shown in red) when compared to the length of the "radial extension" (as defined by the Examiner) of Weiser. Thus, Weiser lacks a radial extension as claimed, since the element of Weiser which the Examiner defines as corresponding thereto lacks a feature of the claimed structure.

Accordingly, the inventive implant as claimed is neither taught nor suggested by Weiser, and withdrawal of the rejection is appropriate. There being no further grounds for objection or rejection, therefore, early and favorable action is respectfully solicited.

Any additional fees or charges required at this time in connection with the application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

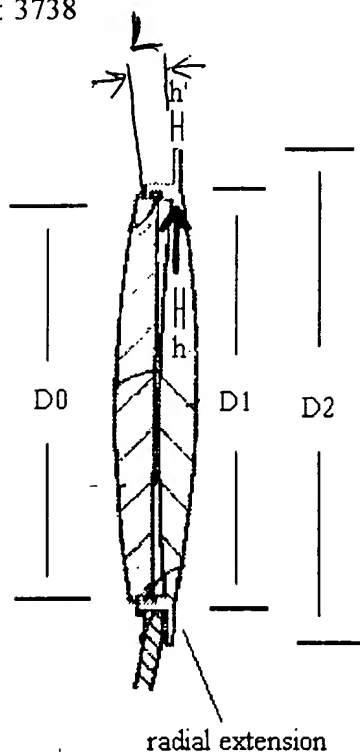
Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By   
\_\_\_\_\_  
Roger S. Thompson  
Reg. No. 29,594  
551 Fifth Avenue, Suite 1210  
New York, N.Y. 10176  
(212) 687-2770

October 13, 2004

Art Unit: 3738

**FIG. 5**

### *Response to Arguments*

9. Applicant's arguments with respect to claim 9 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**